

### **III. REMARKS**

Briefly, this Amendment amends the above-noted currently pending claim in response to the rejections in the Office Action, and to clarify the elements of the claims.

The amendment does not alter the scope of the specification or drawings, and does not present new matter into the application. All amendments and changes are supported by the currently pending specification and drawings.

#### **A. DETAILED ACTION in OFFICE ACTION**

##### **Claim Rejection - 35 USC § 112**

Claims 16-19 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner noted that the tube presented in claim 16 did not have a straight surface, and therefore, could not be parallel to the legs. The examiner also noted the legs do not extend vertically from the tube, but rather adjacent to the tube. With respect to claim 19, the examiner noted the term "sufficiently closed" has no meaning.

##### **Claim Rejection - 35 USC § 102**

Claims 1-2 were rejected under 35 U.S.C. § 102(b) as being anticipated by Armstrong (US 5,988,383).

Claims 16-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Malvasio (US 6,138,963)

##### **Claim Rejection - 35 USC § 103**

Claims 3, 6-7 were rejected as lacking an inventive step under PCT Article 33(3) as being obvious over Armstrong in view of Reynolds (US 5,971,200).

Claims 4-5 and 10-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Armstrong in view of Markson (US 5,782,360).

Claims 8-9 were rejected as lacking an inventive step under PCT Article 33(3) as being obvious over the references applied to claim 6 in further view of Markson.

Claims 8-9 were rejected as lacking an inventive step under PCT Article 33(3) as being obvious over the references applied to claim 12 in further view of Reynolds.

#### **B. Amendments to the Claims**

– Claim 16 has been amended to change subparagraph "a)" from (in pertinent part):

*a) a tube having a generally vertically extending cavity for receiving a tool therein,*

to read:

*a) a body having (i) an open top with an upper surface, (ii) a bottom and (iii) a generally vertically extending tubular cross-section therebetween to establish an upwardly opening cavity for receiving a tool therein,*

This change was made to change recitation of a tube to a body with a tubular-cross-section for improved conformance with the text of the Detailed Description of the Invention, and establish antecedent basis for the upper surface and bottom recited in original claims 18 and 19, respectively.

– In response to the 112 rejection, claim 16 has been further amended to change subparagraph "b)" from:

*b) a pair of elongated legs extending parallel and generally vertically from said tube for slipping into said pair of snug pockets in the tool carrier.*

to read:

*b) a pair of generally vertical, elongated legs connected to said body, said legs being spaced from one another to define a downwardly opening slot therebetween for slipping said legs into said pair of snugly fitted pockets in the tool carrier.*

This change addresses the fact that the tube did not have a straight surface, and therefore, could not be parallel to the legs, and that the legs do not extend vertically from the tube, but rather adjacent to the tube.

-- In further response to the 112 rejection, claim 19 has been amended to delete the phrase "sufficiently closed".

-- In response to the 102 rejection of claim 1, it has been amended to clarify that the front and back panels of the skirt are "planar". With this amendment, claim 1 recites, among other things, planar front and back panels with edge portions interconnected to the adjacent side panels. Such planar panels are discussed in the specification, and contribute to the elimination of need for ties or straps to secure the tool holder in position on the top of the ladder, as well as contributing to the ability of the device to function as a free-standing tool holder. In contrast, Armstrong does not include planar front and back panels, but rather includes one "step-side" panel that is centrally open to enable the user to ascend all steps of the ladder, and that includes straps 18 to secure the tool holder thereof to the top of the ladder. The planar panel arrangement of the currently amended claim 1, when considered with the other elements of the claim, is not disclosed or suggested in Armstrong or the other prior art of record. Therefore, Applicant believes currently amended claim 1 patentably distinguishes over and is allowable in view of Armstrong.

-- In response to the 102 rejection of claim 2, Applicant notes that claim 2 depends from claim 1, and since Applicant believes currently amended claim 1 is allowable, he further believes claim 2 is allowable. Further, claim 2 recites "*the lower edges of said front, back and side panels*

*extend continuously between adjacent interconnected panels to define a continuous, generally rectangular lower skirt perimeter at said constant distance from the top panel."* In view of the open step-side panel, Armstrong clearly does not disclose or suggest the noted limitation of claim 2. The rejection of claim 2 did not discuss or address this continuous lower skirt perimeter limitation. Therefore, Applicant believes that claim 2 was improperly rejected in the Office Action, and if currently amended claim 1 is not allowable, Applicant requests reconsideration of the rejection of claim 2

-- In response to the 102 rejection of claim 16, it has been amended (as noted above), to recite (in pertinent part): *"a pair of generally vertical, elongated legs connected to said body, said legs being spaced from one another to define a downwardly opening slot therebetween for slipping said legs into said pair of snugly fitted pockets in the tool carrier."* This clarifies, among other things, that the legs of the tool holder are physically separated for slipping into a pair of adjacent pockets. Neither Malvasio or the other prior art of record disclose an accessory tool holder as defined in currently amended claim 16. The element 27 of Malvasio, considered to be the leg by the examiner, can not physically be slipped into two adjacent pockets. Therefore, Applicant believes that currently amended claim 16 is allowable.

-- In response to the 102 rejection of claims 17-19, these claims have been amended for conformance with amended claim 16 from which they depend.

-- With regard to the 103 rejections of claims 3-5, Applicant believes they are allowable as depending from currently amended claim 1. Applicant further believes that claims 3-5 were incorrectly rejected in the Office Action, and if currently amended claim 1 is not allowable, requests reconsideration of the rejection of these claims for the reasons discussed below.

Claim 3 as originally presented recited, among other things, elastic members interconnecting adjacent panels for resilient expansion and contraction therebetween. Claim 3

has been amended herein to clarify that the elastic members interconnect "*all adjacent edges of the panels*". There is no motivation of justification in the art, or for one skilled therein, to combine the elastic band of Reynolds to the holder of Armstrong as suggested by the examiner. Armstrong teaches to use ties or straps to secure the holder to the step ladder. In rejecting claim 3, the examiner suggests the noted combination "to allow the cover to stretch over a larger size ladder if necessary". Of the multitude of prior tool holders for step ladders, none provide this motivation. This is only found in the present application. In addition, application of elastic to the Armstrong holder as suggested by the examiner, and placing the Armstrong holder over a larger size ladder to cause the elastic to stretch will also cause the bottom of the step-side panel to separate, resulting in a poor fit on the ladder, not a better fit. Further, provision of the tie straps of Armstrong enables it to inherently snugly fit more than one sized ladder. Moreover, there is no motivation or justification for combining the elastic band of Reynolds with Armstrong in the manner as defined in claim 3. Claim 3 provides for front, back and side panels associated with the respective sides of a ladder for a snug fit thereon, and elastic members interconnecting the panels so that the panels can move in relation to each other, not arbitrarily placed to expand the skirt without regard to how it expands. In short, Applicant believes the rejection of claim 3 was based on the contribution to the art of the present invention, and was therefore improper. For all of the above reasons, Applicant believes claim 3 as originally presented, and as clarified herein, was and remains allowable.

Claim 4 as originally presented recited, among other things, "*a frame structure connected to at least one of said top panel and an upper portion of said skirt*". There is no motivation of justification in the art, or for one skilled therein, to combine the frame of Markson to the holder of Armstrong as suggested by the examiner. In rejecting claim 4, the examiner suggests the

noted combination "to provide a stronger and durable carrier". Of the multitude of prior tool holders for step ladders, none provide this motivation. Armstrong notes that material considerations should provide "tensile strength to withstand the gravitational forces" when the holder is loaded with tools "without physically yielding" (col. 3, lines 41-45). Armstrong further recites a list eight specific suitable materials, and adds "virtually any fabric will suffice" with the noted tensile strength. In view of the Armstrong disclosure, there is clearly no motivation to add a frame to the Armstrong device to make it "stronger", particularly since the frame would only add complexity and cost to a holder that is, from the disclosure, already sufficiently strong. Further, the frame of claim 4 is *"to assist in supporting the tool carrier in an upright position on a horizontal surface."* Use of a frame to achieve this unique aspect of the present invention, as discussed at length in the specification, is not contemplated in the prior art. Even if a frame were added to the Armstrong holder within the teaching therein, it would be added for tensile strength and durability, not to support the holder upright. Therefore, that holder would not meet the limitations of claim 4. In short, the holder and frame combination of claim 4 is not taught in the prior art, nor is there motivation other than the teaching of the present invention for such a combination. Therefore, Applicant again believes the rejection of claim 4 was based on the contribution to the art of the present invention, and was therefore improper. Further, claim 5 recites additional frame limitations to accomplish supporting the holder thereof in an upright position, limitations that are not hinted at, and can not possibly be deduced from the disclosure of Reynolds or any of the prior art of record. Still further, Applicant notes that the Armstrong holder, as well as all prior step ladder tool holders, are fully supported in their normal condition by the step ladder itself, whereas the frame of Markson is necessary to support the cover panels thereof during its normal use. Only the present invention teaches use of a frame to support the

tool holder off of the step ladder. For all of the above reasons, Applicant believes claim 4 as originally presented, and claim 5 depending therefrom, were and remain allowable.

-- In response to the 103 rejection of claim 6, it has been amended to clarify that "all adjacent edges of the panels" are interconnected with elastic members, for movement of the panels in relation to one another. For the reasons discussed above in relation to claims 3, Applicant believes that the original claim 6 was rejected by the improper combination of Armstrong and Reynolds, and further that the clarified claim 6 as currently amended is allowable. For the reasons discussed above in relation to claims 4-5, Applicant believes that claims 8-9 were also improperly rejected, and that they remain allowable, along with claim 7 as depending from clarified claim 6.

-- In response to the 103 rejection of claim 10, it has been amended to include further limitations to the skirt, and claim 12 which depends therefrom has been amended to delete such limitations. For the reasons discussed above in relation to claim 4, Applicant believes claim 10 was rejected on an improper combination of Armstrong and Markson. Applicant further believes that the rejections of claim 12-14 were improper for the reasons discussed above. Moreover, claim 15 recites specific folded-material structure in relation to a holder with a frame and elastic members. This specific folded-material structure is nowhere contemplated or suggested in the prior art, and the Office Action provides absolutely no foundation for the rejection of this claim in view of the recited structure. Therefore, reconsideration of the rejection of claims 10-15 is respectfully requested.

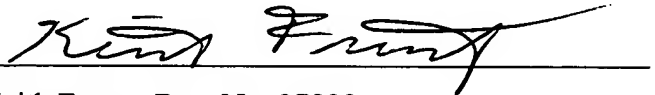
-- Claims 1, 4, 6, 8 and 10 have been further amended to delete the words "adapted to". Applicant does not believe these changes affect the scope of the claims.

In view of the foregoing, Applicant respectfully submits that claims 1-19 are allowable

over the prior art of record, and that the claims are in a condition for allowance.

If the Examiner, after considering this application in light of the present amendment, feels that a response to the amendment should be a final rejection of the application, and if the examiner feels that a discussion with applicant's attorney might serve as a means of avoiding such a rejection and advancing the prosecution of this application to a favorable termination, the examiner is respectfully requested to phone the undersigned attorney and to accord said attorney an opportunity of discussing this application before same is disposed of by a final rejection. The Examiner is assured of complete cooperation in the event that such courtesy is extended.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Keith Frantz", is written over a horizontal line.

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